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OFFICE OF PETITIONS

Applicant: de Jong *et al.*
Serial No.: 09/815,981
Customer No.: 24961
Confirmation No.: 7622
Filed: March 22, 2001
For: **METHODS FOR DELIVERING NUCLEIC
ACID MOLECULES INTO CELLS AND
ASSESSMENT THEREOF**
Art Unit: 1636
Examiner: Sullivan, D.

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Jonathan Ong

PETITION PURSUANT TO 37 C.F.R. §1.181

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Dear Sir:

Applicant hereby submits a Petition pursuant to 37 C.F.R. §1.181 for reconsideration and removal of the finality of the Office Action, mailed September 30, 2003, in connection with the above-captioned application. This Petition is filed within two months of the mailing of the final rejection.

It is respectfully submitted that the Office Action mailed September 30, 2003, (hereinafter the instant Office Action), which was made final, introduces new grounds of rejection of claims 4, 14, and 15 under 35 U.S.C. §103(a) that (i) could have been applied in the previous Office Action; and (ii) were not necessitated by the claim amendments in response to the previous Office Action. Therefore, the Action should not have been made Final.

In the previous Office Action mailed December 16, 2002, (hereinafter the previous Office Action), claims 1-3 and 11-13 were rejected under 35 U.S.C.

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§103(a) as being unpatentable over Felgner *et al.* (International PCT application No. WO 99/13719) or Zelphati *et al.* ((1999) *Hum. Gene Therap.* 10:15-24) in view of Nolan *et al.* (International PCT application No. WO 00/34436). In the instant Office Action, in addition to claims 1-3 and 11-13, claims 4, 14, and 15 are now rejected under 35 U.S.C. §103(a) as being unpatentable over Felgner *et al.* or Zelphati *et al.* in view of Nolan *et al.*

Claim 4 is directed toward a method of claim 1, wherein the nucleic acid molecule is DNA. Claim 14 is directed toward a method of claim 1, wherein the cells are eukaryotic cells. Claim 15 is directed toward a method of claim 14, wherein the cells are primary cells, cell lines, plant cells, or animal cells. The rejection under 35 U.S.C. §103(a) of claims 4, 14, and 15 in the instant Office Action constitutes a new rejection that is not necessitated by amendment because claims 4, 14, and 15 have not been amended between the time that the previous Office Action issued, and the time that the instant Office Action issued. Thus, to the extent that claims 4, 14, and 15 can be rejected, this new rejection could have been applied in the previous Office Action.

In the instant Office Action, the Examiner acknowledges that the rejection of claims 4, 14, and 15 under 35 U.S.C. §103(a) was not set forth in the previous Office Action. The Examiner explains this omission, however, by stating that this was "clearly" the result of a typographical error. The Examiner justifies the rejection as being "clearly" typographical by alleging that all of the cited references teach a nucleic acid that is DNA according to Claim 4 and an animal cell according to Claims 14 and 15.

It is respectfully submitted that this explanation of a "clearly" typographical error is unconvincing. The previous Office Action does not merely fail to list claims 4, 14, and 15 as being rejected under 35 U.S.C. §103(a). Rather, the previous Office Action, while discussing the alleged basis for the rejection under 35 U.S.C. §103(a) of each of claims 1-3 and 11-13, fails to state any particulars of the rejection of claims 4, 14, and 15 (see Paper No. 19

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setting forth the previous Office Action, pp. 12-13). As discussed above, the alleged basis for the rejection of claims 4, 14 and 15 under 35 U.S.C. §103(a) is provided for the first time in the instant Office Action. Therefore, the omission of these claims from the previous rejection under 35 U.S.C. §103(a) cannot be attributed to a mere typographical error.

As further evidence that the failure to reject claims 4, 14 and 15 under 35 U.S.C. §103(a) in the previous Office Action cannot be attributed to a mere typographical error, Applicant notes that these claims were rejected on various grounds under 35 U.S.C. §102(b) in the previous Office Action, and specific bases for their rejection alleged (see Paper No. 19 setting forth the previous Office Action, pp. 7-11). When the claims were in fact rejected, the Examiner listed the claims as being subject to a rejection, and provided the alleged basis for the rejection. Therefore, it is respectfully submitted that Applicant had no reason to believe that claims 4, 14 and 15, were subject to rejection under 35 U.S.C. §103(a) in the previous Office Action.

Failure to withdraw the finality of the instant Office Action denies the Applicant the right to amend the claims, if needed, and/or provide arguments to overcome this rejection. Therefore, since the newly recited rejections of claims 4, 14, and 15 under 35 U.S.C. §103 were not necessitated by amendment and could have been raised in the previous Office Action, the finality of the instant Office Action is improper.

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In light of the above remarks, reconsideration and removal of the finality of the instant Office Action are respectfully requested.

Respectfully submitted,
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